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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,849	07/24/2001	Nobuyuki Kobayashi	P21228	4815

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EXAMINER

SELLERS, DANIEL R

ART UNIT

PAPER NUMBER

2615

DATE MAILED: 11/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/910,849

Applicant(s)

KOBAYASHI ET AL.

Examiner

Daniel R. Sellers

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 September 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: _____.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See the attached paper.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

Response to Arguments

1. Applicant's arguments, see pages 4-5, filed 9/5/06, with respect to claim 1 have been fully considered and are persuasive. The rejection under 35 USC 102(b) of claim 1 has been withdrawn.
2. Applicant's arguments filed 9/5/06 have been fully considered but they are not persuasive. The examiner stated further consideration of the Tanaka reference would need to be considered and after some consideration the 35 USC 103 rejections stand as presented. Tanaka teaches the features of claims 1-2, 5, and 8 throughout several embodiments. The combination of Tanaka and Kubo teaches the features of claims 3-4, and 9-10. The combination of Tanaka and Pawlowski teaches the features of claims 6-7, 11, and 14. The combination of Tanaka, Kubo, and Pawlowski teaches the features of claims 12-13, and 15-16.

Patents are relevant as prior art for all they contain (see MPEP 2123). "The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain." *In re Heck*, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting *In re Lemelson*, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)).

A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including nonpreferred embodiments. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989). See also *Upsher-Smith Labs. v. Pamlab, LLC*, 412 F.3d

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1319, 1323, 75 USPQ2d 1213, 1215 (Fed. Cir. 2005)(reference disclosing optional inclusion of a particular component teaches compositions that both do and do not contain that component); < Celeritas Technologies Ltd. v. Rockwell International Corp., 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998) (The court held that the prior art anticipated the claims even though it taught away from the claimed invention. "The fact that a modem with a single carrier data signal is shown to be less than optimal does not vitiate the fact that it is disclosed.").

3. Regarding claim 1:

Tamura teaches several embodiments and states that they can be combined in any fashion without departing from its concept (Col. 47, lines 47-52). Copywrite protection, or digital rights management, is the main concept of the Tamura reference (Col. 1, lines 6-12 and Col. 2, line 16 - Col. 3, line 2).

In the first embodiment and second embodiment, Tanaka teaches a separate field in the external memory, or flash memory card, which identifies the memory card individually (Col. 8, lines 1-30, and Col. 11, line 51 - Col. 12, line 4). Tanaka teaches an internal memory, where identification data can be recorded (Col. 8, lines 31-39 and Col. 9, lines 16-42, it is inherent that SYS1 must have a storage location for the identification data, "ABC", so that it can compare it with the judging means, JD). In the first embodiment, Tanaka also teaches the control block, which takes some action to prevent unauthorized use (Col. 8, lines 45-62). In the fourth embodiment, Tanaka teaches that the action taken is to display a message that notifies a different external memory, or flash memory card, has been mounted when the identification data, "ABC",

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is different from the identification data in the apparatus, SYS1 (Col. 16, lines 3-12 and lines 48-57). The third and fifth embodiments teach various ways of obtaining the literary works, or digital data (Col. 12, lines 48-55 and Col. 20, lines 46-65). The third embodiment teaches literary works that can be downloaded to a unique flash card (Col. 13, lines 28-62 and Col. 14, lines 2-31). The fifth embodiment is similar (Col. 20, line 66 - Col. 21, line 7- Col. 22, line 15). However, one of ordinary skill can limit the literary work to a specific apparatus and specific external memory using encryption as disclosed in the second, third, and fifth embodiments, and the fifth embodiment teaches a different location for the identification data on the external memory, and the general teachings also teach different locations (Col. 20, lines 60-65 and Col. 7, lines 35-44).

The third embodiment uses the same location, CIS field, as the first two embodiments, and in the fifth embodiment Tanaka teaches that a personal computer cannot change this field, however Tanaka discloses an encryption method utilizing the CIS field and the SYS1 identification data to create unique, individual identifiers (Col. 12, lines 5-45, Col. 15, lines 51-67, and Col. 23, lines 54-67). The cipher, which is created using the apparatus (SYS) identification and the CIS field, is a unique identification data that identifies the external memory individually, which must be stored, at least temporarily, in the internal memory of the apparatus (SYS) so that it can be compared to the cipher that encrypts the data on the external memory (FMC). It is at least stored in part by the fact that it is derived from the apparatus identification.



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